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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,781	02/24/2004	Gerhard D. Klassen	16813-1US	2200

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EXAMINER	
HEFFINGTON, JOHN M	
ART UNIT	PAPER NUMBER
2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/784,781	KLASSEN ET AL.	
	Examiner	Art Unit	
	John M. Heffington	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :24 February 2004, 26 October 2004.

DETAILED ACTION

This action is in response to the original filing of February 24, 2004. Claims 1-20 are pending and have been considered below.

Specification

Content of Specification

(a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

(b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

(c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.

(d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).

(e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

(f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject

matter of the claimed invention. This item may also be titled "Technical Field."

(2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

(g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

(i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

(k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

(l) Sequence Listing, See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

The specification discloses that the instant application claims benefit to a U.S. Provisional Patent Application. The application of the U.S. Provisional Patent Application is incorrectly listed as 60/525,959 and should be listed as 60/525,958.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1,6-8,10 and 11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for previewing new events on a screen, does not reasonably provide enablement for using a single definition for visually modifying an icon. The method in this claim consists of a single step: "visually modifying the one of said applications' icon", and thus is interpreted as a single means/single step claim under MPEP 2164.08(a).

"A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor."

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 recites the limitation "said act of displaying a preview" in claim 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-4,9-12,17-20 rejected under 35 U.S.C. 102(e) as being anticipated by Salmimaa (US 2002/0160817 A1).

Claim 1: Salmimaa discloses a method of a mobile terminal receiving messages (paragraph 0026) and modifying application icons in response to the messages (paragraph 0013).

Claim 2: Salmimaa discloses a method of an application launcher that launches an application associated with a selected icon in response to further user input (paragraph 0038).

Claim 3: Salmimaa discloses a method featuring an icon of a user more prominently when an email from that user is received, i.e. monitoring for new email messages (events) (paragraph 0045).

Claim 4: Salmimaa discloses a method modifying application icons in response to the messages (paragraph 0013), thereby determining which modification should be made to the icon.

Claim 9,17: Salmimaa discloses a method and a Graphical User Interface (GUI) for an application launcher that launches an application associated with a selected icon in response to further user input, for example, a web browser or a document (paragraph 0038).

Claim 10,11,18,19: Salmimaa discloses a method and a Graphical User Interface (GUI) for a mobile terminal that includes a microprocessor and a memory that communicates with one or more content providers via a wireless means (paragraph 0034).

Claim 12,20: Salmimaa discloses a GUI and a hand held wireless device for a mobile terminal that includes a microprocessor and a memory that communicates with one or more content providers via a receiving circuit, i.e. monitoring component (paragraph 0034) and modifying icons, i.e. a modifying component (paragraph 0013).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 5-8, 13-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Salmimaa (US 2002/0160817 A1) in view of Hellebust (US 2005/0248437 A1).

Claim 5: Salmimaa discloses a method modifying application icons in response to the messages (paragraph 0013) as in claim 4 above, thereby determining which modification should be made to the icon, but does not disclose keeping a count of the number of messages received for each icon. Hellebust discloses a method showing the number of messages received under each of the categories (paragraph 0017).

Therefore, it would have been obvious to one having ordinary skill in the art for Salmimaa to include a message count for each icon. One would have been motivated to include a message count for each icon to count the number of messages associated with each icon that have the same profile.

Claim 6,14: Salmimaa discloses a method of a mobile terminal receiving messages (paragraph 0026) and modifying application icons in response to the messages (paragraph 0013) as in claims 1 and 12 above, but does not disclose a method of displaying a preview of content of a new event. Hellebust discloses a method for the display of the wireless device to be updated to reflect that a new message has arrived by displaying the actual message (paragraph 0011). Therefore, it would have been obvious for to one having ordinary skill in the art for Salmimaa to include a view of the actual message for an icon when a new message arrives. One would have been motivated to display the actual message for an icon when a new message arrives in order to display the content of the message rather than just the modification of the icon.

Claim 7,15: Salmimaa discloses a method of a mobile terminal receiving messages (paragraph 0026) and modifying application icons in response to the messages (paragraph 0013) and Hellebust discloses a method for the display of the wireless device to be updated to reflect that a new message has arrived by displaying the actual message (paragraph 0011) as in claims 6 and 12 above. Salmimaa further discloses a

method of an application launcher that launches an application associated with a selected icon in response to further user input (paragraph 0038).

Claim 8: Salmimaa and Hellebust disclose a method for receiving messages (Salmimaa, paragraph 0026), modifying application icons in response to the messages (Hellebust, paragraph 0013) and an application launcher that launches an application associated with a selected icon in response to further user input (Salmimaa, paragraph 0038) as in claim 7 above, but do not disclose displaying a content preview in a dialog box. A dialog box is a very common way to display information separately from another window at the time of the invention. Therefore, it would have been obvious for Salmimaa and Hellebust to display a preview of content in a dialog box. One would have been motivated to display a preview of content in a dialog box in order to maximize display space by displaying separate information over other information, therefore adding a third dimension of display space.

Claim 13,16: Salmimaa discloses a GUI and a hand held wireless device for a mobile terminal that includes a microprocessor and a memory that communicates with one or more content providers via a receiving circuit, i.e. monitoring component (paragraph 0034) and modifying icons, i.e. a modifying component (paragraph 0013) as in claims 12 and 15 above, but does not disclose maintaining a count of items. Hellebust discloses a similar GUI and hand held device that keeps count of items (paragraph 0017). Therefore, it would have been obvious to one having ordinary skill in the art for

Salmimaa to include a message count for each icon. One would have been motivated to include a message count for each icon to count the number of messages associated with each icon that have the same profile.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Heffington whose telephone number is (571) 270-1696. The examiner can normally be reached on Mon - Fri (Alternate Fridays off) 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Myhre can be reached on (571) 270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMH
3/5/2007

James W. Myhre
Supervisory Patent Examiner